

APPLICANT(S): Jeremy Burr
SERIAL NO.: 10/035,896
FILED: 10/18/2001
Page 2

REMARKS

The present Response is intended to be fully responsive to all points of objection and/or rejection raised by the Office Action and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt reconsideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-31 are pending in the application.

CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1, 2, 6-11, 14, 17, 19-24, 27 and 30 under 35 U.S.C. § 103(a), as being unpatentable over Haartsen (US 6,026,297) in view of Peters (US 6,601,093). Specifically, with regard to independent claim 1, the Examiner contended that Haartsen teaches all the elements of this claim except for a synchronization system, which the Examiner contended to be implied by Haartsen, and further contended that it would have been obvious to modify Haartsen to have a synchronization system as described in Peters. As to independent claims 6 and 19, the Examiner contended that Haartsen teaches all the elements of this claim except for a synchronization period, and further contended that it would have been obvious to modify Haartsen to have a period as the Examiner described in Peters.

Applicant respectfully traverses the rejection of claims 1, 2, 6-11, 14, 17, 19-24, 27 and 30 under 35 U.S.C. 103(a). In view of the following remarks, Applicant respectfully requests that the rejections of claims 1, 2, 6-11, 14, 17, 19-24, 27 and 30 be withdrawn.

APPLICANT(S): Jeremy Burr

SERIAL NO.: 10/035,896

FILED: 10/18/2001

Page 3

As is well established, a prima facie showing of Obviousness may only be established if there is a clear suggestion from or in the prior art to make the modifications proposed by the Office Action. *See Gillette Co. v. S.C. Johnson & Son, Inc.* 919 F. 2d 720 (Fed Cir. 1990).

With regard to the rejection of independent claims 6 and 19 and the claims dependent therefrom, the Applicant would like to point out that Peters does not teach or suggest a synchronization period as required by the claims of the present application. Peters teaches a period for assigning an IP address. Such assignment of an IP address would clearly occur after synchronization would be performed and after an ad-hoc network would be established. Therefore, it is respectfully asserted that a prima facie case of obviousness has not been established with respect to independent claims 6 and 19 and the claims dependent therefrom. Accordingly, Applicant respectfully request that the rejection of claims 6 and 19 and their dependent claims under 35 USC 103(a) be withdrawn at least for this reason.

It is further asserted that the combination of the Haartsen system with synchronization as described in Peters is improper for all of the reasons discussed below. Therefore, it is respectfully submitted that the following arguments in response to the rejection of independent claim 1 are also applicable to the rejection of independent claims 6 and 19.

In addition, Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992). The Office Action does not indicate a basis for motivation by a person skilled in the art at the time the invention to combine Haartsen and Peters. Applicant respectfully assert that there is no basis or motivation to combine Haartsen and Peters, *inter alia*, because the methods described by those two references are unrelated in both purpose and functionality. Applicant respectfully asserts that the method of each of Haartsen and Peters relates to a different function and is directed to achieve a different goal. Furthermore, each of the Haartsen and Peters references addresses a different problem. Haartsen addresses the problem of enabling a wireless unit to contemporaneously be a member of multiple independently operating self-organized wireless local area networks (see Abstract, Figure 2, Col. 1 lines 5-9) In addition, the purpose of the method describe by

APPLICANT(S): Jeremy Burr
SERIAL NO.: 10/035,896
FILED: 10/18/2001
Page 4

Haartsen is clearly the ability to operate the same wireless unit in two or more piconets. Haartsen applies the function of moving from a first piconet to a second piconet during a hold time of the first piconet by using the second piconet address and clock offset (See Figure 3, col. 4 lines 12-34, Col. 3 lines 46-64, Col 4 line 63 to Col. 5 line 26).

Peters addresses the problem of performing address resolution in an ad-hoc networking environment and, more specifically, the problem of providing and receiving an IP address of a device within the network (See Abstract, Col. 1. lines 5-10). The purpose of the method described by Peters is to solve these problems. Peters applies the function of resolving address information to the wireless device by adding two indicators and communicates the indicators along with the IP information of the device. (See Abstract, Figs 2 and 3 and the description of Figs 2 and 3)

The Office Action indicated that the motivation to combine Haartsen with Peters comes from the fact that Peters provides a "Synchronization system". Applicant believes that in reaching this conclusion, the Examiner may have misinterpreted the purpose of each of the Haartsen and Peters references. In addition, Applicant respectfully submits that, as clarified by the remarks herein, even in hind sight, the context of the claimed invention would not have led a person skilled in the art to seek a combination as suggested in the Office Action.

Applicant respectfully asserts that the combination of Haartsen with Peters does not meet the requirements for a determination of obviousness in that neither Haartsen nor Peters provides the necessary impetus to combine one teachings with the other. In addition, neither Haartsen nor Peters teaches or suggests the advantages of Applicants' claimed invention.

As discussed above, Haartsen describes a method that enables a piconet device to be shared by two piconets. As is known in the art, a piconet is defined as a network of devices connected in an ad hoc fashion using Bluetooth technology. A piconet is formed when a connection is made between at least two devices such as, for example, a portable PC and a cellular telephone. According to the Bluetooth standard, piconet can support up to eight devices. When a piconet is formed, one device acts as the master while the other devices act as slaves for the duration of the piconet connection.

As further discussed above, Peters describes a method and a system for resolving address information (e.g. IP address) in an ad-hoc networking (e.g. piconet) intended to solve

APPLICANT(S): Jeremy Burr
SERIAL NO.: 10/035,896
FILED: 10/18/2001
Page 5

the problem of providing and receiving IP addresses on piconets. This represents a different problem from that intended to be solved by Haartsen.

Furthermore, according to M.P.E.P. §2143.01, if a proposed modification would render the device shown in the cited patent being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Office Action indicated that the synchronization method shown in Haartsen could be modified to include the "synchronization system" shown in Peters because the synchronization system of Peters implies the "synchronization system" of Haartsen. Applicant respectfully submits that the combination of Haartsen and Peters cannot make Applicants claimed invention obvious because the teachings of Peters would render the synchronization taught in Haartsen unsatisfactory for its intended purpose, *inter alia*, because the layer 2 connection described in Peters includes a standard synchronization method that cannot be satisfied by the synchronization the Examiner deemed to be implied by Haartsen. Specifically, it is respectfully asserted that the standard synchronization of Peters, if applied to the Haartsen communication device, will cause the Haartsen device to fail an attempted synchronization with a second device.

In view of the above, Applicants respectfully submit that the rejections of claims 1, 2, 6-11, 14, 17, 19-24, 27 and 30 should be withdrawn.

In the Office Action, the Examiner rejected claims 3-5, 12-13, 18, 25-26 and 31 under 35 U.S.C. § 103(a), as being unpatentable over Haartsen (US 6,026,297) in view of Peters (US 6,601,093) as applied to claims 1, 6, and 19 above and further in View of Jacquent et al. (US 6,590,891). Since claims 3-5, 12-13, 18, 25-26 and 31 are dependent directly or indirectly from claims 1, 6 and 19, Applicant respectfully traverses the rejection of claims 3-5, 12-13, 18, 25-26 and 31 under 35 U.S.C. 103(a) in view of the above remarks to claims 1, 6 and 19. Accordingly, Applicant respectfully asserts that the rejections of claims 3-5, 12-13, 18, 25-26 and 31 should be withdrawn.

In the Office Action, the Examiner rejected 15, 16, 28 and 29 under 35 U.S.C. § 103(a), as being unpatentable over Haartsen (US 6,026,297) in view of Peters (US 6,601,093) as applied to claims 1, 6, and 19 above and further in View of Du et al. (US 6,603,740).

APPLICANT(S): Jeremy Burr

SERIAL NO.: 10/035,896

FILED: 10/18/2001

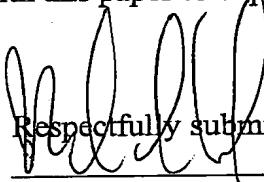
Page 6

Since claims 15, 16, 28 and 29 are dependent directly or indirectly from claims 6 and 19, Applicant respectfully traverses the rejection of claims 15, 16, 28 and 29 under 35 U.S.C. 103(a) in view of the above remarks to claims 1, 6 and 19. Accordingly, Applicant respectfully asserts that the rejections of claims 15, 16, 28 and 29 should be withdrawn.

In view of the foregoing remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.


Respectfully submitted,

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